

Applicants: Philip W. Ingham et al.
Serial No.: 08/954,771
Filed: October 20, 1997
Doc. No.: 319993 .1

107. The method of claim 106, wherein said neuronal cells are selected from the group consisting of motor neurons, cholinergic neurons, dopanergic neurons, serotenergic neurons and peptidergic neurons.--

REMARKS

Claims 49-107 have been added. Support for the new claims may be found in the specification as originally filed. Accordingly, no new matter has been introduced by this amendment.

In the restriction requirement under 35 U.S.C. § 121, the Examiner alleges that there are three distinct inventions as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a method of modulating growth, differentiation, or survival with a hedgehog polypeptide, classified in class 514, subclass 12.
- II. Claims 42, 43 and 48, drawn to hedgehog polypeptide or fragment thereof, classified in class 530, subclass 350.
- III. Claims 44-47, drawn to nucleic acid encoding a hedgehog polypeptide or fragment thereof, classified in class 536, subclass 23.1.

According to the Examiner, the inventions claimed in Groups I through III are distinct and unrelated and have acquired a separate status in the art because of their recognized divergent subject matter.

Applicants respectfully disagree. The Examiner's attention is directed to M.P.E.P. § 803, which states that:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction requirement to be valid, the Examiner must establish the following two criteria:

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(1) the existence of independent and distinct inventions (35 U.S.C. § 121); and
(2) that the search and examination of the entire application cannot be made without
serious burden (M.P.E.P. § 803).

Applicants respectfully submit that the Examiner has not shown that the second
requirement has been met. This is particularly true for the inventions of Groups I and II. Group
I is directed to a method of modulating growth and is classified in class 514 subclass 12, Group
II is directed to polypeptides and is classified in class 530 and subclass 350. Applicants believe
that extending the search to cover three additional claims and one additional subclass would not
constitute a serious burden upon the Examiner. Therefore, Applicants submit that it would not
be an undue burden on the Examiner to search the claims of Groups I and II together.
Consequently, Applicants urge reconsideration and withdrawal of the restriction requirement at
least in so far as it pertains to the invention of Groups I and II.

If there are any other fees due in connection with the filing of this response, please charge
the fees to our **Deposit Account No. 06-1448**. If a fee is required for an extension of time under
37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be
charged to our Deposit Account.

Respectfully submitted,
FOLEY, HOAG, & ELIOT

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